

### REMARKS

This Application has been carefully reviewed in light of the Office Action mailed November 28, 2006. At the time of the Office Action, Claims 2-14 were pending in this Application. Claims 4-6 and 8-14 were previously withdrawn due to an election/restriction requirement. Claim 1 was previously cancelled by Applicants without prejudice. Claims 2, 3, and 7 were rejected. Claim 2 has been amended to further define various features of Applicants' invention. Claims 15-18 have been added. Applicants respectfully request reconsideration and favorable action in this case.

#### **Specification Objections**

The specification was objected to due to informalities, specifically, the application contained no section headings as provided in 37 C.F.R. 1.77(b). Applicants attached hereto a Substitute Specification to overcome this objection.

#### **Rejections under 35 U.S.C. § 102**

Claims 2, 3, and 7 were rejected by the Examiner under 35 U.S.C. §102(b) as being anticipated by U.S. Patent 4,825,680 issued to Coe et al. ("Coe"). Applicants respectfully traverse and submit the cited art does not teach all of the elements of the claimed embodiment of the invention.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Furthermore, "the identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co. Ltd.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Applicants respectfully submit that the cited art as anticipated by the Examiner cannot anticipate the rejected Claims, because the cited art does not show all the elements of the present Claims.

The Examiner stated that Coe discloses all the steps of independent Claim 2. Applicants respectfully disagree. The method as defined in Claim 2 is directed to the manufacture of a compensation collar. The originally submitted specification defines a compensation collar as an element which compensates for an idle stroke of, for example, an

injection valve. Original independent Claim 1 included the limitation of a compensation collar in the body of the claim.

Coe is not directed to the manufacture of a compensation collar. Coe discloses the manufacture of a metal blank material, a metal substrate for memory disks. Coe is in particular directed to the production of ultra-precisely formed smooth and flat surfaces. See Coe, col. 1, lines 7-16.

Therefore, Coe is not related art and a person skilled in the art of manufacturing compensation collars would not consider Coe. Claim 1 is directed to a method for producing a compensation collar for an injection valve. However, because the body of the claim did not recite an injection valve and to further prosecution, Applicants, therefore, restricted Claim 1 to compensation collars for injection valves.

Applicants respectfully submit that the dependent Claims are allowable at least to the extent of the independent Claim to which they refer, respectively. Thus, Applicants respectfully request reconsideration and allowance of the dependent Claims. Applicants reserve the right to make further arguments regarding the Examiner's rejections under 35 U.S.C. §102 or §103(a), if necessary, and do not concede that the Examiner's proposed combinations are proper.

**Information Disclosure Statement**

The Examiner indicated that the Information Disclosure Statement filed January 16, 2004 failed to comply with 37 CFR 1.98(a)(2), requiring legible copies of each cited foreign patent document. Applicants respectfully submit that these references were previously cited in the parent U.S. Patent Application Serial Number 09/743,183. However, Applicants submit a new Information Disclosure Statement and PTO Form 1449, along with copies of the references for the Examiner's review and consideration.

**CONCLUSION**

Applicants have made an earnest effort to place this case in condition for allowance in light of the amendments and remarks set forth above. Applicants respectfully request reconsideration of the pending claims.

Applicants believe there are no fees due at this time, however, the Commissioner is hereby authorized to charge any fees necessary or credit any overpayment to Deposit Account No. 50-2148 of Baker Botts L.L.P.

If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicants' attorney at 512.322.2545.

Respectfully submitted,  
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Date: February 28, 2007

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Attachment: Substitute Specification